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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/047,018
Filing Date: January 15, 2002
Appellant(s): BODIN, WILLIAM

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 25 February 2006 appealing from the Office action mailed 21 March 2006.

1. ***Real Party in Interest***

A statement identifying the real party in interest is contained within the brief.

2. ***Related Appeals and Interferences***

A statement indicating Applicant is unaware of any related appeals or interferences is contained within the brief.

3. ***Status of Claims***

The statement of the status of the claims contained within the brief is correct.

4. ***Status of Amendments***

The Appellant's statement of the status of amendments after final rejection contained within the brief is correct.

5. ***Summary of Claimed Subject Matter***

The summary of the invention contained within the brief is correct.

6. ***Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 4-8, 11-15 & 18-21 are rejected under 35 U.S.C. § 103(a) over the teachings of US Patent 6,092,114 to Shaffer.

Claims 2, 3, 9, 10, 16 & 17 are rejected under 35 U.S.C. § 103(a) over the combined teachings of US Patent 6,092,114 to Shaffer in view of US Patent 5,339,361 to Schwalm.

The above-noted rejections are set forth in a prior Office Action, mailed on 21 March 2006. The prior Office Action is included herein below:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 4-8, 11-15 & 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over extensive consideration of US Patent 6,092,114 to Shaffer.

3. Regarding Claims 1, 8 & 15, Shaffer discloses a system, method and computer program for email administration comprising the steps of:

- receiving in a transcoding gateway from a client device one or more email display status attributes describing one or more email display capability statuses for a domain, (Col. 2, lines 30-65 & Col. 6, lines 31-53);
- receiving in the transcoding gateway from a sender an email display capability status request for the domain, wherein the capability status request comprises a domain identification, (Col. 6, lines 6-67 & Col. 7, lines 1-38), (Examiner notes that Shaffer discloses a message sent by a

sender to the server where a determination is made based on client capabilities, wherein said message would obviously be a default means of requesting capability status, especially in light of the fact that Shaffer discloses a capability status determination, a conversion means, and a notification to sender means, all related to the ability of the client/target device to receive the sender's message, and wherein the sender is notified of a client's inability to receive the message based on conversion requirements, which requirements are obviously an indication of the client/domain ability/capability to receive the sender's message. Additionally, the motivation to request client capability is also found within Shaffer which teaches the need for files to be accessible to the client device as well as a conversion consideration, wherein both conversion time and data loss are important access file/sharing issues, (Col. 1, lines 55-67 & Col. 2, lines 1-27));

- finding, in dependence upon the domain identification, at least one email display capability status record for the domain, wherein the email display capability status record for the domain comprises at least one of the email display capability status attributes, (Col. 6, lines 6-67 & Col. 7, lines 1-38), (Examiner notes that Shaffer discloses wherein if an attachment does not need conversion, it is transmitted to the client/target. Moreover, Shaffer teaches a checking, determining and converting process, wherein the client does not intervene with the same, and wherein the client/target

email display capability status attributes are determinative of the need for sender notification and/or conversion); and

- sending at least one of the email display capability status attributes to the sender, (Col. 6, lines 6-67 & Col. 7, lines 1-38), (Examiner notes that Shaffer teaches sender notification concerning conversion requirements, which conversion requirement obviously represent client/target display capability status attributes).

Thus, Claims 1, 8 & 15 are found to be unpatentable over considerable consideration of the teachings of Shaffer.

4. Regarding Claims 4, 11 & 18, Shaffer is relied upon for those teachings noted herein. Shaffer further discloses:

- receiving an email in a transcoding gateway, the email comprising an email address and at least one digital object, (Claims 1-20);
- determining, in dependence upon display capability attributes and the email address, whether the digital object is to be transcoded in the transcoding gateway, wherein the determining results in a determination, (Col. 5, lines 65-67; Col. 6; & Col. 7, lines 1-38);
- forwarding the email, including the digital object, to the email address, if the determination is that the digital object is not to be transcoded in the transcoding gateway, (Col. 5, lines 65-67; Col. 6; & Col. 7, lines 1-38); and
- if the determination is that the digital object is to be transcoded in the transcoding gateway, carrying out the further steps of transcoding the

digital object into a transcoded digital object; and downloading the transcoded digital object to a destination client device, (Col. 5, lines 65-67; Col. 6; & Col. 7, lines 1-38).

Thus, Claims 4, 11 & 18 are found to be unpatentable over considerable consideration of the teachings of Shaffer.

5. Regarding Claims 5, 12 & 19, Shaffer is relied upon for those teachings noted herein. Shaffer further discloses:

- transcoding the digital object further comprises transcoding the digital object into a digital file having a digital format and a file name, (Col. 5, lines 65-67; Col. 6; & Col. 7, lines 1-38); and
- downloading the transcoded digital object further comprises downloading the digital file to a destination client device at an internet address recorded in an Internet address field of a client device record, the client device record having recorded in a mailbox address field in the client device record, a mailbox address identical to the email address of the email message, (Col. 2, lines 30-67; Col. 3; Col. 4, lines 1-65; Col. 5, lines 65-67; Col. 6; & Col. 7, lines 1-38), (Examiner notes that Shaffer clearly teaches a message server with a universal register/lookup table/database and access control/user verification functionality, wherein an email address generally clearly and obviously reads upon an Internet address having a mailbox address identical to an email address); and

- recorded in a digital file format code field of the client device record, a digital file format code indicating that the client device represented by the client device record is capable of receiving the digital format of the digital file, (Col. 2, lines 30-67; Col. 3; Col. 4, lines 1-65; Col. 5, lines 65-67; Col. 6; & Col. 7, lines 1-38), (Examiner notes that Shaffer clearly teaches an access capability determination as well as multimedia attachments which are well-known to be digital in format, (Col. 1, lines 16-23).

Thus, Claims 5, 12 & 19 are found to be unpatentable over considerable consideration of the teachings of Shaffer.

6. Regarding Claims 6, 13 & 20, Shaffer is relied upon for those teachings noted herein. Shaffer further discloses wherein determining in dependence upon display capability attributes and the email address, whether the digital object is to be transcoded in the transcoding gateway, further comprises finding a capability record having a connection address equal to the email address, (Col. 2, lines 30-67; Col. 3; Col. 4, lines 1-65; Col. 5, lines 65-67; Col. 6; & Col. 7, lines 1-38). Thus, Claims 6, 13 & 20 are found to be unpatentable over considerable consideration of the teachings of Shaffer.

7. Regarding Claims 7, 14 & 21, Shaffer is relied upon for those teachings noted herein. Shaffer further discloses wherein forwarding the email further comprises forwarding the entire email, including the digital object, to an email client in another transcoding gateway in a client device, (Col. 2, lines 30-67; Col. 3; Col. 4, lines 1-65;

Col. 5, lines 65-67; Col. 6; & Col. 7, lines 1-38). Thus, Claims 7, 14 & 21 are found to be unpatentable over considerable consideration of the teachings of Shaffer.

8. Claims 2, 3, 9, 10, 16 & 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of US Patent 6,092,114 to Shaffer in view of US Patent 5,339,361 to Schwalm.

9. Regarding Claims 2, 9 & 16, Shaffer is relied upon for those teachings noted herein. Though Shaffer discloses an email administration system inclusive of access control, (Shaffer – Col. 1, lines 58-62), Shaffer does not specifically disclose wherein the email display capability status request includes a sender identification identifying the sender, and the method further comprises determining, in dependence upon the sender identification, that the sender is authorized to send email to a connection address in the domain. Schwalm specifically teaches a sender verification functionality, (Schwalm – Abstract & Fig. 2), wherein it would have been obvious to incorporate a sender verification means into the Shaffer system for purposes of providing controlled access and transmission/receipt confirmation by authorized parties, (Schwalm – Col. 1, lines 14-52), within an email system which already requires user verification like that of Shaffer, and wherein it would have been obvious to augment the Shaffer controlled access means by implementing sender verification as well. Thus, Claims 2, 9 & 16 are found to be unpatentable over considerable consideration of the teachings of Shaffer and Schwalm.

10. Regarding Claims 3, 10 & 17, Shaffer and Schwalm are relied upon for those teachings noted herein. Schwalm further discloses wherein determining that the sender

is authorized to send email to a connection address in the domain further comprises sending in dependence upon the sender identification and in dependence upon the domain identification, at least one sender authorization record, (Col. 1, lines 14-67; Col. 2, lines 1-15; & Claims 1-23), wherein:

- the sender authorization record represents authorization for the sender to send email to a connection address in the domain, (Col. 1, lines 14-67; Col. 2, lines 1-15; & Claims 1-23);
- the sender authorization record comprises sender authorization attributes including a connection address in the domain, (Col. 1, lines 14-67; Col. 2, lines 1-15; & Claims 1-23), (Examiner notes that in light of Shaffer, the sender record obviously includes connection addresses of those domains where the sender is authorized to transmit data/email for purposes of transmission verification); and
- finding at least one email display capability record for the domain further comprises finding in dependence upon the domain identification and in dependence upon the connection address, at least one email display capability status record for the domain, (Schwalm - Col. 1, lines 14-67; Col. 2, lines 1-15; & Claims 1-23), (Shaffer - Col. 6, lines 6-67 & Col. 7, lines 1-38), (Examiner again notes that Shaffer discloses wherein if an attachment does not need conversion, it is transmitted to the client/target. Moreover, Shaffer teaches a checking, determining and converting process, wherein the client does not intervene with the same, and wherein

the client/target email display capability status attributes are determinative of the need for sender notification and/or conversion).

Thus, Claims 3, 10 & 17 are found to be unpatentable over considerable consideration of the teachings of Shaffer and Schwalm.

7. *Response to Arguments*

7.1 Claims 1, 4-8, 11-15 and 18-21 are in fact unpatentable under 35 U.S.C. § 103(a) over Shaffer, as the proposed modification of Shaffer does in fact teach or suggest all of the claim limitations of Appellant's claims, (Appeal Brief, pp. 7-8)

7.1.A. Shaffer in fact teaches or suggests receiving in a transcoding gateway from a client device one or more email display status attributes describing one or more email display capability statuses for a domain, (Appeal Brief – p.9)

Appellant vehemently argues, "Shaffer's email server capable of file-format conversion does not receive one or more email display status attribute describing one or more email display capability statuses for a domain *as claimed in the present application*", (Appeal Brief, p.10), and Examiner respectfully disagrees as was noted in the previous Office Action dated 21 March 2006 as follows:

> In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an email display capability status specifically comprising display device availability, display device recent usage, display availability, power status or recent capability use; and a communication distinct from any email message designed to inform a sender of email display capability status during preparation of an email message) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Examiner additionally notes that in the determining of access/display capabilities and in performing the requisite conversions, Shaffer clearly teaches a display capability status. Examiner further

> notes that email addresses are well-known to reside on domains. Moreover, Examiner implicitly admits nothing within the prior office action, as when Examiner's arguments are understood **in their entirety**, they clearly and distinctly show why Applicant's claim language, as written, is found to be unpatentable in view of the prior art.

Simply put, Appellant's invention, **as claimed**, makes no mention whatsoever of Appellant's particular definition for "email display capability status attributes", namely a definition comprising "availability" and "recent usage" information, (Appeal Brief, p. 10). **As claimed**, Appellant's method of email administration only requires:

> "receiving in a transcoding gateway from a client device one or more email display status attributes describing one or more email display capability statuses for a domain", (Appeal Brief, p.8).

So, the question is, broadly and reasonably interpreted, does the Shaffer reference teach, "email display capability status attributes", and Examiner finds that it clearly does. Specifically, and as admitted by Appellant, "Shaffer's access capabilities merely describe whether a client device has an application installed on the client device to open, (i.e.: display), a particular type of file", (Appeal Brief, p.12), wherein Examiner finds that any indication of the ability to open a particular type of file is clearly a "display capability status attribute", (i.e.: the attribute denoting whether or not a particular file type is capable of being displayed), wherein if the particular type of file is capable of being displayed, then, (per Shaffer), the status is clearly affirmative regarding the presence of the application needed for opening the type of file, and wherein if the particular type of file is not capable of being displayed, then, (per Shaffer), the status is

clearly negative regarding the presence of the application needed for opening the type of file.

As Appellant is aware, per *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993), proper examination of the claims does not require limitations from the specification to be not read into the claims. Thus, Examiner's interpretation of Appellant's claims was proper and reasonable. As Appellant's claim language does not enumerate "email display capability status attributes" as specifically comprising "availability" and "recent usage" information, the fact that Appellant now argues that definition, as distinguishing over the prior art, is irrelevant. The prior art clearly teaches "email display capability attributes", and as such renders Appellant's claim language as written, unpatentable over the prior art of record.

7.1.B. Shaffer in fact teaches or suggests receiving in a transcoding gateway from a sender an email display capability status request for the domain, wherein the capability status request comprises a domain identification, (Appeal Brief – p.12)

Appellant argues "Shaffer's email server never once receives an email display capability status request...for a domain", (Appeal Brief, p.13), and Examiner respectfully disagrees. As noted herein, Shaffer clearly teaches an "email display capability status attribute", obviously comprising an "email display capability status" as noted herein above and within the prior Office Action dated 21 March 2006, as follows:

> Examiner notes that Shaffer clearly teaches a message server with a universal register/lookup table/database and access control/user verification functionality, wherein an email address generally clearly and obviously reads upon an Internet address having a mailbox address identical to an email address); and

> recorded in a digital file format code field of the client device record, a digital file format code indicating that the client device represented by the client device record is capable of receiving the digital format of the digital file, (Col. 2, lines 30-67; Col. 3; Col. 4, lines 1-65; Col. 5, lines 65-67; Col. 6; & Col. 7, lines 1-38), (Examiner notes that Shaffer clearly teaches an access capability determination as well as multimedia attachments which are well-known to be digital in format, (Col. 1, lines 16-23)

Thus, the next question is whether said status request, as noted within Shaffer, is for a "domain", such that "the capability status request comprises a domain identification", (Appeal Brief, p. 13), and Examiner notes that it indeed is. Specifically, as noted by Appellant, Shaffer discloses, "receiving an email at an email server, checking the file format of an attachment, determining whether a client device is capable of accessing the attachment, converting, locally or remotely as needed, the attachment to a format accessible by the client device, and notification of the sender if conversion is not possible", (Appeal Brief, pp. 12-13).

That noted, the next question is whether an email/attachment comprises a request for a domain, or more specifically, a domain identification. According to the Microsoft Computer Dictionary, an e-mail address is defined as:

> An e-mail address typically consists of a name that identifies the user to the mail server, followed by an at sign (@) and the host name and domain name of the mail server".

Thus, e-mail clearly comprises a domain identification. Moreover, according to Appellant's own specification," a "domain" refers to a group of client devices administered together and identified by a common network address, typically an Internet protocol address, that resolves to a domain name", (Appellant's specification, p. 33). Therefore, per Appellant's own definition, a group of individuals administered together

and identified by a common network address, (i.e.: the same e-mail server, such as Earthlink or Comcast), would be a "domain", and as such, Shaffer's e-mail clients clearly comprise members of a domain using the same domain identification, (i.e.: e-mail server). **As claimed**, Appellant's method of email administration only requires:

> "receiving in the transcoding gateway from a sender an email display capability status request for the domain, wherein the capability status request comprises a domain identification", (Appeal Brief, Appendix of Claims – Claim 1).

Therefore, Appellant's argument regarding Shaffer's orientation towards a single client device rather than an entire domain is irrelevant in that Appellant's claim language makes no mention whatsoever of a status request for an "entire" domain. In fact, as written, Appellant's claim language only requires the status request to comprise some sort of domain identification. As noted herein, Shaffer's email clearly comprises a domain identification, and as such, renders Appellant's claim language, as written, unpatentable. Again, per *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993), proper examination of the claims does not require limitations from the specification to be not read into the claims. Examiner's interpretation of Appellant's claims was proper and reasonable. As Appellant's claim language does not enumerate a status request for an "entire" domain, the fact that Appellant now argues that interpretation, as distinguishing over the prior art, is irrelevant. The prior art clearly teaches, "a display capability status request for the domain...comprising a domain identification", (i.e.: the e-mail address), and as such renders Appellant's claim language as written, unpatentable over the prior art of record.

Appellant's repeated argument that Shaffer does not teach an "email display capability status" as "claimed in the present invention", has been addressed herein above. Specifically, Appellant solely argues that since Shaffer does not teach an "email display capability status", Examiner's "argument that the second element of Claim 1 is disclosed" is also not taught for being dependent upon a showing of an "email display capability status". As Examiner has clearly shown that Shaffer does in fact teach an "email display capability status" as "claimed in the present invention", by Appellant's own logic, Shaffer clearly discloses the second element of Claim 1.

Lastly, Appellant's argument that though "Shaffer's email server is capable of file-format conversion based on the applications installed on a client device, (per the universal application register, as stored on a lookup table, which universal application register identifies all access capabilities of various client devices that are used to access email stored at the local server (i.e.: gateway) – Appeal Brief, p.11, referring to Shaffer), it does not teach or suggest receiving in a transcoding gateway from a client device one or more "email display status attributes"", (Appeal Brief, p. 11), (as argued repeatedly herein above), and again, Examiner respectfully disagrees. As noted herein, Appellant's definition of what comprises "email display status attributes" is not found anywhere within the claim language, as written. As Examiner has repeatedly shown, the teachings of Shaffer clearly read upon Applicant's claim language, as written, teaching "email display status attributes", and rendering the same unpatentable.

So, the question remaining pertains to whether Shaffer discloses a "transcoding gateway", and Examiner finds that it does. Specifically, per Appellant's specification, a

"transcoding gateway" is a server capable of transcoding messages form one format to another, (Appellant's specification, p. 15), wherein the term "transcoding" clearly means, "converting". Thus, any server, (like that taught by Shaffer – as admitted by Appellant), capable of receiving an email at an email server, checking the file format of an attachment, determining whether a client device is capable of accessing the attachment, converting, locally or remotely as needed, the attachment to a format accessible by the client device, and notification of the sender if conversion is not possible", (Appeal Brief, pp. 12-13), clearly acts as a "transcoding gateway" per Appellant's own definition. Moreover, in receiving an email at an email server, checking the file format of an attachment and determining whether a client device is capable of accessing, (i.e.: displaying) the attachment, Shaffer clearly and obviously teaches receiving in a transcoding gateway from a client device one or more "email display status attributes".

7.1.C. Shaffer in fact teaches or suggests finding, in dependence upon the domain identification, at least one email display capability status record for the domain, wherein the email display capability status record for the domain comprises at least one of the email display capability status attributes, (Appeal Brief – p.16)

As noted herein above, Appellant's argument regarding Shaffer's orientation towards a single client device rather than an entire destination domain is irrelevant in that Appellant's claim language makes no mention whatsoever of a status request for an "entire" destination domain. Again, per *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993), proper examination of the claims does not require limitations from the specification to be not read into the claims. Examiner's

interpretation of Appellant's claims was proper and reasonable. As Appellant's claim language does not enumerate a status request for an "entire" destination domain, the fact that Appellant now argues that interpretation, as distinguishing over the prior art, is irrelevant. The prior art clearly teaches, "a display capability status request for the domain...comprising a domain identification ", (i.e.: the e-mail address), and as such renders Appellant's claim language as written, unpatentable over the prior art of record.

Appellant's repeat argument regarding "email display capability status" has been addressed numerous times herein above. Finally, Appellant argues that "nothing in Shaffer ever detects or advises a sender of the status of the email display capability of a device", (Appeal Brief, p. 17), which is confusing in light of Appellant's admission to the contrary noting, "Shaffer at column 6, lines 6-67 and column 7, lines 1-38 discloses in summary, receiving an email at an email server, checking the file format of an attachment, determining whether a client device is capable of accessing the attachment, converting, locally or remotely as needed, the attachment to a format accessible by the client device, and notification of the sender if conversion is not possible", (Appeal Brief, pp. 16). Clearly, in notifying the sender that conversion is not possible, sender is advised as to the status of the email display capability of the device.

7.1.D. Shaffer in fact teaches or suggests sending at least one of the email display capability status attributes to the sender, (Appeal Brief – p.17)

Appellant's argument regarding Shaffer's orientation towards a single client device rather than an entire destination domain wherein "the sender can select a target

device that is actually presently available on-line", (Appeal Brief, p. 18), is irrelevant in that Appellant's claim language makes no mention whatsoever of a status request for an "entire" destination domain wherein "the sender can select a target device that is actually presently available on-line". Additionally, as noted herein above, Appellant's claims make no mention whatsoever of defining "email display capability status" as "when the email display capability of the device is powered on" or "when a capability was recently used", (Appeal Brief, p. 18).

Again, per *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993), proper examination of the claims does not require limitations from the specification to be not read into the claims. Examiner's interpretation of Appellant's claims was proper and reasonable. As Appellant's claim language does not enumerate a status request for an "entire" destination domain wherein "the sender can select a target device that is actually presently available on-line and an "email display capability status" defined as "when the email display capability of the device is powered on" or "when a capability was recently used", the fact that Appellant now argues that interpretation, as distinguishing over the prior art, is irrelevant. The prior art clearly teaches Appellant's claim language as written, rendering the same unpatentable over the prior art of record.

7.2 Claims 2, 3, 9, 10, 16 & 17 are in fact unpatentable under 35 U.S.C. § 103(a) over Shaffer in view of Schwalm, (Appeal Brief, pp. 19)

7.2.A. The proposed combination of Shaffer and Schwalm does in fact teach or suggest all of the claim limitations of Appellant's claims, (Appeal Brief – p.20)

Appellant argues simply that as Shaffer does not teach every element of the Independent claims, the combined teachings of Shaffer and Schwalm do not teach every element of those claims dependent thereon, and Examiner respectfully disagree, noting that Shaffer does indeed teach each and every element of Appellant's claimed invention, as written, and as such, by Appellant's logic, teaches every element of those claims dependent thereon. In fact, Appellant does not deny those teachings enumerated within Schwalm and cited by Examiner, and as such, Examiner will assume that Appellant finds Schwalm to teach those elements of the claimed invention as cited by Examiner in the last Office Action dated 21 March 2006.

7.2.B. There is in fact a proper suggestion or motivation to combine Shaffer and Schwalm, (Appeal Brief – p.20)

Appellant argues that no suggestion or motivation existed for the combination of Shaffer and Schwalm, and Examiner respectfully disagrees noting the prior Office Action dated 21 March 2006, as follows:

> In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Examiner notes that proper motivation was disclosed within paragraph 9 of the prior office action, as noted herein above.
>
> In response to applicant's argument that there is no reasonable expectation of success in the proposed modification of the prior art, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention

must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Here, Examiner respectfully disagrees with Applicant noting that the combined teachings clearly and obviously render Applicant's claims, as written, unpatentable.

Regarding Applicant's argument that Shaffer teaches away from Applicant's claimed invention, as Shaffer has "no concern whatsoever for the actual status of any client device", (Amendment – p.14), Examiner respectfully disagrees noting that Shaffer specifically teaches consideration of client device capabilities in order to make a determination as to conversion requirements. As device capabilities clearly read upon device status, Examiner again finds Applicant's claim language, as written, to be unpatentable in view of the prior art.

In response to applicant's argument that Schwalm is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Examiner respectfully disagrees with Applicant noting that the combined.

Paragraph nine of the Final Office Action dated 21 March 2006 reads as follows:

Though Shaffer discloses an email administration system inclusive of access control, (Shaffer – Col. 1, lines 58-62), Shaffer does not specifically disclose wherein the email display capability status request includes a sender identification identifying the sender, and the method further comprises determining, in dependence upon the sender identification, that the sender is authorized to send email to a connection address in the domain. Schwalm specifically teaches a sender verification functionality, (Schwalm – Abstract & Fig. 2), wherein it would have been obvious to incorporate a sender verification means into the Shaffer system for purposes of providing controlled access and transmission/receipt confirmation by authorized parties, (Schwalm – Col. 1, lines 14-52), within an email system which already requires user verification like that of Shaffer, and wherein it would have been obvious to augment the Shaffer controlled access means by implementing sender verification as well. Thus, Claims 2, 9 & 16 are found to be unpatentable over considerable consideration of the teachings of Shaffer and Schwalm.

Thus, as both Shaffer, (Shaffer – Col. 3, lines 58-62) and Schwalm, (Schwalm – Col. 1, lines 15-52), clearly teach an email messaging/electronic information transfer system incorporating security means, the incorporation of the Schwalm "controlled access" means into the Schwalm messaging system would have been obvious for purposes of user identity verification, (i.e.: receipt of electronic information by authorized parties – Schwalm). Thus, a prima facie case for obviousness has been properly made, and as such, the rejection should be affirmed.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Arrienne M. Lezak

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